

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q61200

Hiroshi OGAWA, *et al.*

Appln. No.: 09/810,230

Group Art Unit: 1774

Confirmation No.: 6907

Examiner: Camie S. THOMPSON

Filed: March 19, 2001

For: RADIATION IMAGE CONVERSION PANEL AND MANUFACTURING METHOD  
THEREFOR

**REQUEST FOR REINSTATEMENT OF APPEAL FILED UNDER 37 C.F.R. § 41.31  
(FORMERLY UNDER 37 C.F.R. § 1.193(b)(2)(ii))**

**MAIL STOP APPEAL BRIEF - PATENTS**

Commissioner for Patents

P.O. Box 1450

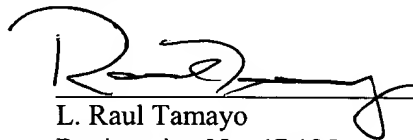
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed February 17, 2005, Appellants hereby request reinstatement of the Appeal filed September 3, 2004 (Appeal Brief filed December 3, 2004) and submit herewith a Supplemental Appeal Brief.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this paper is attached.

Respectfully submitted,



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WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: July 18, 2005

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For: RADIATION IMAGE CONVERSION PANEL AND MANUFACTURING METHOD  
THEREFOR

**SUPPLEMENTAL APPEAL BRIEF UNDER 37 C.F.R. § 41.37  
(FORMERLY UNDER 37 C.F.R. § 1.193(b)(2)(ii))**

**MAIL STOP APPEAL BRIEF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellants submit the following:

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SUPPLEMENTAL APPEAL BRIEF  
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**I. REAL PARTY IN INTEREST**

The real party in interest is Fuji Photo Film Co., Ltd., the assignee of the present application. The assignment was recorded on March 19, 2001, at reel 011628, frame 0566.

**II. RELATED APPEALS AND INTERFERENCES**

Appellants, Appellants' counsel, and the assignee of the application are not aware of any other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**III. STATUS OF CLAIMS**

Claims 1-10 are pending in the application.

Claims 1-6 and 9-10 are rejected.

Claims 7-8 are withdrawn from consideration for being drawn to non-elected invention.

Claims 1-6 and 9-10 are being appealed.

Claims 1-6 and 9-10 are set forth in their entirety in the Claims Appendix submitted herewith.

**IV. STATUS OF AMENDMENTS**

On August 3, 2004, a Response Under 37 C.F.R. § 1.116 was filed in response to the final Office Action mailed March 3, 2004, together with a petition for two months of extension time. The Response did not include an amendment to the claims.

An Advisory Action was mailed September 7, 2004, indicating that the remarks submitted in the August 3<sup>rd</sup> Response have been considered but do not place the application in condition for allowance.

In response to Appellants' Notice of Appeal filed September 3, 2004, and Appellants' Appeal Brief filed December 3, 2004, the Examiner issued a non-final Office Action mailed February 17, 2005, based on a newly discovered reference.

**V. SUMMARY OF THE CLAIMED SUBJECT MATTER**

Claim 1 is drawn to a radiation image conversion panel. Page 12, lines 23-26, of the specification. The radiation image conversion panel comprises a support body. Page 35, lines 1-20. The radiation image conversion panel also comprises a phosphor layer provided on the support body. Paragraph bridging pages 25 and 26. Claim 1 requires the phosphor layer to contain a binding agent, a phosphor, and at least aryl carboxylic acid or alicyclic carboxylic acid. Paragraph bridging pages 25 and 26.

Claim 1 specifically requires the aryl carboxylic acid or alicyclic carboxylic acid to be expressed by the formula  $R-R^1-COOX$  or by the formula  $R-COOX$ . Paragraph bridging pages 25 and 26. According to Claim 1, R represents (1) an aryl group; (2) an aryl group, replaced with an alkyl group whose number of carbons is 1 to 5, a hydroxyl group, a carboxylic acid group, or a halogen group; (3) a hydroaryl group; or (4) a hydroaryl group (alicyclic group), replaced with an alkyl group whose number of carbons is 1 to 5, a hydroxyl group, or a halogen group;  $R^1$  is a hydrocarbon radical whose number of carbons is 1 to 12; and X represents a hydrogen atom, alkaline metal, or  $-N^+(R^2)_4$  (where  $R^2$  represents an alkyl group whose number of carbons is 2 or less). Paragraph bridging pages 25 and 26.

Claim 2 is a dependent claim. It depends from Claim 1. Claim 2 narrows the definition of R in the formula  $R-R^1-COOX$  or the formula  $R-COOX$ , such that the letter R is either (1) an aryl group or (2) an aryl group, replaced with an alkyl group whose number of carbons is 1 to 5, a hydroxyl group, or a halogen group. Paragraph bridging pages 25 and 26, as well as page 26, lines 6-16.

Claims 3 and 4 are dependent claims. Claim 3 depends from Claim 1, and Claim 4 depends from Claim 2. Claims 3 and 4 contain the same substantive limitation. Specifically, Claims 3 and 4 require the binding agent to be a thermoplastic elastomer with a softening temperature or melting point of 30 °C to 150 °C. Page 32, lines 2-19.

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Claims 5 and 6 are dependent claims. Claim 5 depends from Claim 3, and Claim 6 depends from Claim 4. Claims 5 and 6 contain the same substantive limitation. Specifically, Claims 5 and 6 require the binding agent to be polyurethane resin. Page 32, lines 11-19.

Claims 7-8 are withdrawn from consideration for being drawn to non-elected invention.

Claim 9 is a dependent claim. It depends from Claim 1. Claim 9 requires the phosphor layer to have been formed by dispersing and coating the phosphor, the aryl carboxylic acid or alicyclic carboxylic acid, and the binding agent. Paragraph bridging pages 30 and 31. Claim 9 further requires the phosphor layer and the support body to have been bonded together by placing the phosphor layer on the support body and compressing the phosphor layer at a temperature higher than the softening temperature or melting point of the binding agent. Paragraph bridging pages 30 and 31.

Claim 10 is a dependent claim. It depends from Claim 1. Claim 10 requires a surface process to have been performed on particles of the phosphor with the aryl carboxylic acid or alicyclic carboxylic acid. Paragraph bridging pages 30 and 31. Claim 10 also requires the phosphor layer to be formed by dispersing and coating the surface-processed phosphor particles and the binding agent. Paragraph bridging pages 30 and 31. Claim 10 further requires the phosphor layer and the support body to have been bonded together by placing the phosphor layer on the support body and compressing the phosphor layer at a temperature higher than the softening temperature or melting point of the binding agent. Paragraph bridging pages 30 and 31.



**VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The issue presented for review is:

whether the Examiner erred in rejecting Claims 1-6 and 9-10 under 35 U.S.C. § 102(b) as being anticipated by EP 0 234 385 ("EP '385").

## **VII. ARGUMENT**

### **The Rejection**

Claims 1-6 and 9-10 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by EP 0 234 385 ("EP '385").

Focusing on independent Claim 1, and summarizing, the Examiner asserts that EP '385 discloses a radiation image storage panel comprising a support and a phosphor layer provided on the support, which comprises a binder and stimuable phosphor dispersed therein, as per instant Claim 1. Appellants refer to Section No. 4 at page 2 of the Office Action mailed February 17, 2005, wherein the Examiner refers to page 2 of EP '385. The Examiner also asserts that "the reference discloses that the phosphor layer contains a compound having a metal salt of an organic acid wherein the organic acid can be salicyclic acid (aryl carboxylic). Appellants refer again to Section No. 4 at page 2 of the Office Action, wherein the Examiner refers to page 5 of EP '385.

### **The Error in the Rejection**

The error in the rejection is that not each and every element of independent Claim 1 is found, either expressly or inherently described, in EP '385 as required by 35 U.S.C. § 102.

### **Why Claims 1-6 and 9-10 are Patentable Under 35 U.S.C. § 102**

The claimed aryl carboxylic acid or alicyclic carboxylic acid does not encompass the metal salt of organic acid disclosed by EP '385.

The claims recite a specific aryl carboxylic acid or alicyclic carboxylic acid. In particular, the aryl carboxylic acid or alicyclic carboxylic acid recited in Claim 1 is an aryl carboxylic acid or alicyclic carboxylic acid having the formula  $R-R^1-COOX$  or  $R-COOX$ .

In the formula  $R-R^1-COOX$  or  $R-COOX$ , X represents a hydrogen atom, alkaline metal, or  $-N^+(R^2)_4$  (where  $R^2$  represents an alkyl group whose number of carbons is 2 or less). Thus, X in the present claims represents a univalent metal or group.

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A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The metal salts of organic acids identified by the Examiner do not anticipate the specific aryl carboxylic acid or alicyclic carboxylic acid recited in Claim 1 because they do not fall within the scope of the specific aryl carboxylic acid or alicyclic carboxylic acid recited in Claim 1.

In this regard, EP '385 discloses the following at page 10, lines 40-41, with respect to its metal salts of organic acids:

It is presumed that a portion of organic acids in the metal salt of organic acid having the formula (IV), is substituted by iodine to form  $(R^7COO)_{m-1}MI$ .

As is understood by one of ordinary skill in the art, the disclosure above indicates that "m-1" is greater than or equal to one and "m" is greater than or equal to two. Thus, "M" cannot be univalent. Indeed, Appellants have reviewed the examples of EP '385 and submit that M is not univalent in any of the compounds disclosed therein.

In short, EP '385 does not show the identical invention of Claim 1 in as complete detail as is contained in Claim 1.

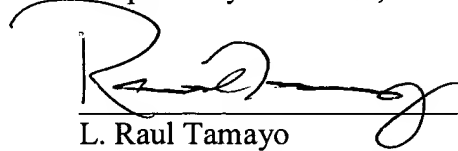
For at least the foregoing reason, Appellants respectfully submit that EP '385 does not anticipate the invention of Claim 1, or the inventions of Claims 2-6 and 9-10, at least by virtue of their dependence (either directly or indirectly) from Claim 1.

Unless a check is submitted herewith for the fee required under 37 C.F.R. §41.37(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

SUPPLEMENTAL APPEAL BRIEF  
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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "L. Raul Tamayo", written over a horizontal line.

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Date: July 18, 2005

**CLAIMS APPENDIX**

CLAIMS 1-6 and 9-10 ON APPEAL:

1. A radiation image conversion panel comprising at least:

a support body; and

a phosphor layer provided on said support body;

wherein said phosphor layer contains a binding agent, a phosphor, and at least aryl carboxylic acid or alicyclic carboxylic acid, expressed by the following general Formula:



in which R represents (1) an aryl group; (2) an aryl group, replaced with an alkyl group whose number of carbons is 1 to 5, a hydroxyl group, a carboxylic acid group, or a halogen group; (3) a hydroaryl group; or (4) a hydroaryl group (alicyclic group), replaced with an alkyl group whose number of carbons is 1 to 5, a hydroxyl group, or a halogen group;  $R^1$  is a hydrocarbon radical whose number of carbons is 1 to 12; and X represents a hydrogen atom, alkaline metal, or  $-N^+(R^2)_4$  (where  $R^2$  represents an alkyl group whose number of carbons is 2 or less).

2. The radiation image conversion panel as set forth in claim 1, wherein the letter R in said general Formula is either (1) an aryl group or (2) an aryl group, replaced with an alkyl group whose number of carbons is 1 to 5, a hydroxyl group, or a halogen group.

3. The radiation image conversion panel as set forth in claim 1, wherein said binding agent is thermoplastic elastomer with a softening temperature or melting point of 30 to 150 °C.

4. The radiation image conversion panel as set forth in claim 2, wherein said binding agent is thermoplastic elastomer with a softening temperature or melting point of 30 to 150 °C.

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5. The radiation image conversion panel as set forth in claim 3, wherein said binding agent is polyurethane resin.

6. The radiation image conversion panel as set forth in claim 4, wherein said binding agent is polyurethane resin.

9. The radiation image conversion panel as set forth in claim 1, wherein said phosphor layer is formed by dispersing and coating said phosphor, said aryl carboxylic acid or alicyclic carboxylic acid, and said binding agent, and said phosphor layer and said support body are bonded together by placing said phosphor layer on said support body and compressing said phosphor layer at a temperature higher than the softening temperature or melting point of said binding agent.

10. The radiation image conversion panel as set forth in claim 1, wherein a surface process is performed on particles of said phosphor with said aryl carboxylic acid or alicyclic carboxylic acid, said phosphor layer is formed by dispersing and coating said surface-processed phosphor particles and said binding agent, and said phosphor layer and said support body are bonded together by placing said phosphor layer on said support body and compressing said phosphor layer at a temperature higher than the softening temperature or melting point of said binding agent.

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**EVIDENCE APPENDIX:**

Pursuant to 37 C.F.R. § 41.37(c)(1)(ix), submitted herewith are copies of any evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner and relied upon by Appellant in the appeal.

NONE

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**RELATED PROCEEDINGS APPENDIX**

Submitted herewith are copies of decisions rendered by a court or the Board in any proceeding identified about in Section II pursuant to 37 C.F.R. § 41.37(c)(1)(ii).

NONE